

REMARKS/ARGUMENTS

Claims 1-7 and 21-35 were pending. Claim 7 is allowed. Claims 21-35 were objected to as dependent upon a rejected base claim but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 3-6 have been canceled.

Claim Rejections – 35 U.S.C. §102

Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as being anticipated by Yamasaki et al., on the ground that they are product-by-process claims. Claim 1 recites “a leadframe having a chemically-etched surface.” Claim 3 has been canceled.

The Applicants respectfully traverse the Examiner’s interpretation of Claim 1 as a product-by-process claim. Reconsideration and withdrawal of this rejection is respectfully requested.

According to the Manual of Patent Examining Procedure, § 2113, the term “etched” should normally be treated as a structural limitation. The Manual states:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.

Applying this rule to specific types of claim language, the M.P.E.P. cites with approval the holding in the case of In re Garner, where the Court held that the phrase “interbonded one to another by interfusion” is a structural limitation. In so holding, the Court noted that:

“intermixed,” “ground in place,” “press fitted,” “**etched**,” and “welded” . . . have been separately held capable of construction as structural, rather than process, limitations. [Emphasis added.]

The presence of the word “chemically” in Claim 1 does not affect this conclusion. In the Garner case, the claim further specified that the “interfusion” took place while the particles were “in a pyroplastic state.” The Court held:

Taking the view we do that the just-recited limitation is structural in nature we do not find it necessary to consider the additional limitation "while in a pyroplastic state * * *" as the mere presence of a method limitation in an article claim which is otherwise allowable would not so poison the claim as to render it unpatentable."

Applying this holding to the present situation, Claim 1 would clearly be allowable if it simply recited an "etched surface." The presence of the word "chemically" does not "poison" what is an otherwise allowable article claim.

The fact that the Gernero case is cited in the Manual of Patent Examining Procedure indicates that the Office considers that case to be good authority on the question of what constitutes a structural limitation.

Yamasaki et al. do not teach or suggest an etched surface. Claim 1 is therefore allowable over Yamasaki et al.

This argument is based on the proper interpretation to be given Claim 1 and does not raise new issues or require a new search. The Office Action of August 12, 2004, raised the issue of whether Claim 1 is a product-by-process claim (page 4, lines 2-3), and the Examiner acknowledges that the closest prior art he has uncovered – Yamazaki et al. – does not teach a leadframe having an etched surface (see page 2, lines 20-23, of the February 1, 2005 Office Action). Accordingly, the Applicants respectfully submit that this argument can be properly considered after final rejection.

Claim Rejections – 35 U.S.C. §103

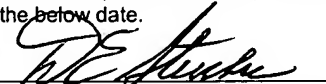
Claims 2 and 4-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamasaki et al. as applied to Claims 1 and 3 and further in view of Abbott et al. Regarding Claims 2 and 4, The Examiner cited Abbott et al. as teaching "a lead frame comprising copper alloy (Col. 4, lines 39-40)." Claim 2 recites "said leadframe consists essentially of copper alloy." Claims 4-6 have been canceled.

Claim 2 depends from Claim 1. As described above, Claim 1 is allowable over Yamasaki et al. taken alone. Abbott et al. do not overcome the deficiencies of Yamasaki et al. insofar as the patentability of Claim 1 is concerned. In particular, Abbott et al. do not teach or suggest a leadframe having an etched surface. Therefore, Claim 2 is allowable over the combination of Yamasaki et al. and Abbott et al.

For the above reasons, Applicants respectfully request allowance of Claims 1, 2, 7 and 21-35. Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 982-8200, ext. 1.

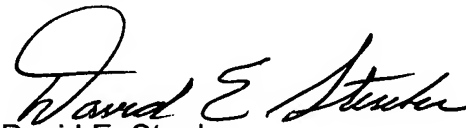
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5/2/05
Date of Signature

Respectfully submitted,


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